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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/718,200	11/20/2003	Marcus Dehlin	1988.68755	9819

7590 05/02/2006
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EXAMINER

PICKETT, JOHN G

ART UNIT	PAPER NUMBER
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3728

DATE MAILED: 05/02/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/718,200

Applicant(s)

DEHLIN ET AL.

Examiner

Gregory Pickett

Art Unit

3728

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 November 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 November 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Priority

1. This application is a CIP of PCT/SE02/01600 (6 September 2002) and PCT/SE01/02496 (21 May 2003). However, as best determined by the examiner, claims 1-17 appear to be directed to subject matter that lacks support in the parent cases and therefore are not entitled to the benefit of priority. Specifically, the parent case fails to provide adequate support for the board reinforced with a polymer of claim 1 or the polymer extrusion coated board of claim 14. Accordingly, the effective filing date of claims 1-17 is the filing date of the instant application, **20 November 2003**.

Information Disclosure Statement

2. The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609.04(a) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1-17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites the limitation "the packaged product" in line 3. There is insufficient antecedent basis for this limitation in the claim. Examiner recommends changing the word "the" to --a--.

Claims 2-16 are dependent on claim 1 and are rejected for the above reason.

Regarding claim 14, a single claim which claims both an apparatus and the method steps of using the apparatus is indefinite under 35 U.S.C. 112, 2nd paragraph. *Ex parte Lyell*, 17 USPQ2d 1548 (Bd. Pat. App. & Inter. 1990). Further, attempts to claim a process without setting forth any steps involved in the process generally raises an issue of indefiniteness under 35 U.S.C. 112, 2nd paragraph. *Ex parte Erlich*, 3 USPQ2d 1011 (Bd. Pat. App. & Inter. 1986).

Claims 15-17 are dependent on claim 14 and are rejected for the above reason.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 14-17 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claim 14 is directed to neither a machine nor a process, but rather embraces or overlaps two different statutory classes of invention, while the statute is drafted so as to set forth the statutory classes in the alternative only. See MPEP 2173.05(p).

Moreover, claim 14 is not a proper definition of a process. *Ex parte Dunki*, 153 USPQ 678 (Bd. App. 1967). See also MPEP 2173.05(q).

Claims 15-17 are dependent on claim 14 and are rejected for the above reason.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1-5, 7, 9, 11, 14, 15, and 17 are rejected under 35 U.S.C. 102(e) as being anticipated by Jones et al (US 6,752,272 B2; hereinafter Jones).

Claim 1: Jones discloses a child-resistant carton package comprising an outer sleeve **1**, an insert **3** carrying a packaged product, and a locking mechanism **13/24/25** or **10**. Jones anticipates a fiber-based board (paperboard) reinforced with a polymer to increase resistance to tearing (see Col. 4, lines 10-14 and Col. 6, lines 9-13).

Claim 2: Jones anticipates an extrusion-coated board (Col. 6, lines 23-25).

Claim 3: Jones anticipates polyester (see Col. 6, lines 16-19).

Claim 4: Jones anticipates polyesters, of which PET is a subset.

Claim 5: Jones anticipates coating on both sides (Col. 6, line 11).

Claim 7: Jones anticipates the coating on both the sleeve and the insert (Col. 4, lines 10-14).

Claim 9: The laminate of Jones is delaminable.

Claim 11: Jones discloses a hole when item **13** is depressed.

Claim 14: Insofar as the examiner can determine the scope of the claim, Jones anticipates the use of a polymer extrusion board (Col. 6, lines 23-25) in a child-resistant carton package comprising an outer sleeve **1**, an insert **3**, and a locking mechanism **13/24/25**.

Claim 15: Jones anticipates polyesters, of which PET is a subset.

Claim 17: Jones anticipates the coating on both the sleeve and the insert (Col. 4, lines 10-14), which include the locking mechanism.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 6 and 16 rejected under 35 U.S.C. 103(a) as being unpatentable over Jones, as applied to claims 2 and 14 above, and further in view of Holbert et al (US 2003/0148110 A1; hereinafter Holbert).

Jones discloses the claimed invention except for the inner reinforcement layer. Holbert discloses a paperboard/polymer laminate with an inner reinforcement layer **14**, which may be polyester (see paragraph [0021]). It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the board of Jones with an inner reinforcement layer as taught by Holbert in order to improve tear resistance (see Holbert paragraph [0010]).

7. Claims 8, 12, and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jones, as applied to claims 1 and 2 above, and further in view of Schwenk (US 3,654,842).

Jones discloses the claimed invention except for the polymer shield and heat-sealing with seam overlapping.

Schwenk discloses a polymer shield (Figure 5) and heat-sealing with seam overlapping (Figure 7). It would have been obvious to one of ordinary skill in the art at the time the invention was made to form the carton of Jones by heat-sealing as taught by Schwenk in order to form a more durable bond.

Allowable Subject Matter

8. Claim 10 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.


Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gregory Pickett whose telephone number is 571-272-4560. The examiner can normally be reached on Mon-Fri, 11:30 AM - 8:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on 571-272-4562. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Greg Pickett
Examiner
27 April 2006


Mickey Yu
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